

**REMARKS**

Upon entry of the present amendment, claims 1-4 will remain pending in the above-identified application and stand ready for further action on the merits.

The amendments made herein to the abstract, specification, and claims do not incorporate new matter into the application as originally filed. For example, the specification and claims have been amended in accordance with suggestions by the Examiner in the outstanding office action, and the abstract has been amended to reflect changes earlier made in the prior response of September 8, 2003, but now fully complying with the provisions of 37 CFR 1.121.

Regarding the amendments to the claims, these simply serve to ensure that the claims fully comply overcome the Examiners grammatical objections as set forth in the outstanding office action. In this respect, it is submitted that the instant claim amendments do not affect the scope of the claims, or otherwise raise estoppel issues for failing to comply with a provision of title 35 of the United States Code.

Regarding the amendment to the abstract, this has simply been done in order to provide an abstract of "no more than 150 words in length" as requested in the Office Action.

Based on such considerations, entry of the current amendment is respectfully requested as it does not introduce new matter into the application as originally filed, does not raise new issues for the Examiner's consideration, and at the same time puts the specification and claims in better form for purposes of appeal, and/or simplifies issues for appeal in the matter of the instant application.

***Provisional Interview Request***

Should the present response not place the instant case in condition for allowance, the Examiner is respectfully requested to contact the undersigned so that a personal interview may be scheduled at the Examiner's earliest convenience. It is believed that such an interview would help to coalesce any remaining issues existing in the case, and thereby also allow applicants to expedite further prosecution of the pending claims towards allowance. Such an interview would also help applicants better determine what issues are appropriate and/or ripe for appeal in the matter of the instant case.

***Objection to Abstract***

The prior outstanding objection to the abstract is requested to be withdrawn based upon the submission herewith of a new abstract, which is less than 150 words in length, and which fully complies with the provisions of 37 CFR 1.121.

***Specification Objection***

The specification has been objected to under 35 USC § 112, first paragraph. Reconsideration and withdrawal of this objection is requested based upon the amendment of page 1 of the specification herein. It is noted that the amendment to the specification is in accordance with comments set forth in paragraph number "3." of the Office Action.

***Claim Objections***

Claims 1-4 have been objected to based on certain informalities. Reconsideration of the claim objection is requested based upon the amendments made herein to the claims.

Further to the above, it is noted that claims 1-4 as instantly amended positively and distinctly set forth Applicants' invention as they see fit. Proper antecedent basis is utilized in the claims for all elements recited. Accordingly, withdrawal of the claim objection is required.

***Claim Language Interpretation***

The USPTO's comments at paragraph "5." of the office action do not effect the literal scope of the pending claims and/or limit the equivalents that are protected and encompassed thereby.

***Claim Rejections Under 35 USC § 102***

Claims 1-4 have been rejected under 35 USC § 102(b) as being anticipated by Clear et al. US 5,368,584 (US '584) and Buell et al. US 5,221,274 (US '274). Reconsideration and withdrawal of this rejection is requested based upon the following considerations.

***Incorporation of Earlier Remarks***

On September 8, 2003, the Applicants responded to the instant rejection. Please see page 8, line 15 to page 12, line 21 of the response filed on September 8, 2003. Such remarks occurring at pages 8-12 of the prior response are incorporated herein by reference in their entirety, inasmuch as they remain appropriate to support and evidence the patentability of each of the pending claims 1-4 over the cited art of Clear et al. and Buell et al.

Distinctions over the Cited Art

In order to apply the instant rejection against the pending claims under the provisions of 35 USC § 102, the Examiner relied on the fact that the cited Clear et al. '584 patent incorporates certain portions of the Buell et al. '274 disclosure therein.

Particularly, at column 14, line 27, et seq., Clear et al. incorporate the earlier Buell et al. disclosure as follows.

... While a disposable diaper of the present invention can be constructed with a single elastic waist feature encircling the wearer, *the discussion regarding the elastic waist feature will focus on diapers having a pair of elastic waist features, at least one, and preferably both, being constructed according to the technologies described in U.S. patent application Ser. No. 07/750,775, "Absorbent Article With Dynamic Elastic Waist Feature Having A Predisposed Resilient Flexural Hinge", Buell, Clear & Falcone, filed on Aug. 22, 1991, allowed; the specification and drawings of which are incorporated herein by reference. ...*

... While the diaper 20 of the present invention preferably has the elasticized side panels 30 disposed in the second waist region 58; alternatively, the diaper 20 may be provided with elasticized side panels 30 disposed in the first waist region 56 or in both the first waist region 56 and the second waist region 58. *While the elasticized side panels 30 may be constructed in a number of configurations, examples of diapers with elasticized side panels positioned in the ears (ear flaps) of the diaper are disclosed in ... and the hereinbefore referenced U.S. patent application*

*Ser. No. 07/750,775 of Buell, Clear & Falcone, filed on Aug. 22, 1991 allowed; each of which are incorporated herein by reference. ...*

While the closure system may take on a number of configurations such as adhesive tape tabs, mechanical closure tape tabs, fixed position fasteners, or any other means for tensioning the elasticized waistband as are known in the art; as shown in FIG. 1, the closure system preferably comprises a waist closure system 40 comprising at least one, typically a pair of, first attachment components 46 and at least one second attachment component 48. *More preferably, the closure system additional comprises a primary fastening system 38 such that the diaper 20 has a dual tension fastening system 36. Preferred embodiments of a diaper having a dual tension fastening system are described in ... and the above referenced U.S. patent application Ser. No. 07/750,775 of Buell, et al. filed on Aug. 22, 1991, allowed; the specification and drawings of each being incorporated herein by reference.*

However, it is submitted that even upon combining the disclosure of Buell et al. '274 with that of Clear, one does not arrive at the instant invention as claimed. That is, one does not achieve an absorbent member having each of the limitations recited in the pending claims, and as a result the instant invention as claimed is not anticipated.

While Clear et al., may inherently discuss the possibility of a diaper having a waistband portions, that may be worn on either the front or back side of a wearer, e.g., see column 16, lines 62-68, the mere addition of the disclosure of Buell et al. to that of Clear et al., does not

result in one of the advantageous absorbent articles of the invention, or meet all of the limitations of any of pending claims 1-4.

In setting forth the rejection, the USPTO appears to be applying the following logic and/or reasoning.

- (i) Clear et al. '584 incorporates the disclosure of Buell et al. '274;
- (ii) Clear et al. '584 inherently teaches the possibility of a waist region on the front or back of a wearer;
- (iii) Buell et al. '274 only teaches positioning its waistband 35 on the front of the wearer;
- (iv) Buell et al. '274 teaches the extension force of the waistband 35 is less than that of the side panel 30; and
- (v) Based on items (i) - (iv) above, Clear et al. '584, must inherently provide for the Buell et al. '274 waistband 35 and side panel 30 with the relation of force in the waistband being  $\leq$  to that in the side panel.

However, such logic and such reasoning on the USPTO's part does not arrive at the instant invention as claimed under the provisions of 35 USC § 102 or 35 USC § 103(a), based on the following considerations.

In the disclosure of Buell et al. '274, at column 45, lines 23-30 the following is taught regarding the relative extension force strengths of the waistband and side panel.

...While the extension forces of the elasticized waistband 35 may be greater than the extension forces of the elasticized side panels 30, in a preferred embodiment of the present invention, the extension forces of the elasticized waistband 35 at its designed extensions is less than or equal to the extension forces of each elasticized side panel 30 at its designed extensions. (emphasis added).

However, even based on this disclosure in Buell et al. '274, one of ordinary skill would not be able to understand which extension force (waistband or side panel) is greater in absorbent articles of either Buell et al. '274, or Clear et al. '584 (which incorporates the Buell et al. '274 disclosure). This is because of the following two points:

- (1) In both the embodiments of Buell et al. '274 and Clear et al. '584, there occur side panels that run and overlap with the waist portion or an end of the waistband portion. As a result, it is difficult or impossible to know or determine, with any precision what the extension force of the waistband portion is verses that of the side panels.
- (2) When comparing the extension force of the waistband of Clear et al. '584 or Buell et al. '274, with the side panel, one would necessarily be comparing a combined extension force of the waistband and side panel portions with that of the side panels (due to side panel overlap with the waist portion or an end of the waistband portion).

Consequently, one skilled in the art, would find it irrational to conclude that the disclosure of Clear et al '584 (or Buell et al. '274) would ever meet the limitations of the



instant claims, which explicitly state in part as follows (see claim 1):

...and said under-waist portion has a greater extension stress than said waist opening portion in a width direction of the diaper.

Apart from the above considerations, in Buell et al. '274 at column 45, lines 30-42, the following is disclosed regarding extension strengths.

... An elasticized waistband 35 having lower extension forces than that of the elasticized side panels 30 provides for easy stomach movement without displacing the diaper on the child. The higher extension force elasticized side panels allow for small dimensional changes over the hip and under the stomach to keep the product comfortably in tension on the wearer. This design provides better fit, less leakage and improved comfort for the wearer through the reduction of sagging, gapping, rollover and roll-in at the front of the diaper and overall sliding/slipping of the diaper or diaper absorbent core on the wearer during use. (emphasis added)

Briefly, as can be understood from the above disclosure in Buell et al. '274, the phrase "an elasticized waistband 35 having lower extension forces" is aimed at being used on the front side, and not on the backside having fastening tapes. On the other hand, the phrase "the higher extension force elasticized side panels 30", which is thereafter described is intended to be used on the backside (see Figure 1). As such, the disclosure of Buell et al. '274 intends that one utilize

an elasticized waistband 35 and elasticized side panels 30 in a manner where the same are oppositely positioned to each other (see Figure 1).

The dimensional changes of the human waist are well known in the art, with the dimensional change of the human waist being bigger at the stomach side/front side waist portion than at the backside waist portion. As a result, it is preferable for the stomach side/front side waist portion of a diaper to elongate more easily than the backside waist portion thereof. From such a viewpoint, the above noted disclosure of Buell et al. '274 can be better understood.

Thus, even if the disclosure of Buell et al. '274 is technically incorporated into the disclosure of Clear et al. '584, one of ordinary skill in the art would not arrive at the instant invention as claimed, based on the fact that (i) Buell et al. '274 only teaches positioning its waistband 35 on the front of the wearer, and (ii) Buell et al. '274 is only concerned with placing fastening tapes on backside of its absorbent member. Accordingly, it follows that one utilizing the incorporated teachings of Buell et al. '274 in Clear et al. '584, would not envision or otherwise reach a disposable diaper as instantly claimed, wherein the fastening tapes are positioned in the following manner (see instant claim 1):

... a waist opening portion and an under-waist portion being present in a portion of the diaper having said fastening tapes, the waist opening portion being provided with a waist elastic member and the under-waist portion being provided with a plurality of under-waist elastic members, in the width direction of the diaper.... (emphasis added)

It is noted that nowhere in the cited disclosure of Buell et al. '274, is there provided any teaching or disclosure regarding any aim to control the relational forces in the waistband and the side panel for fitting or following to the body when its absorbent member is being worn by a wearer, and there is no aim to control the relational force where the fastening tapes are placed. This is, of course, counter to the purpose and function of the disposable diapers of the instant invention.

The above stated differences clearly evidence that neither the Buell et al. '274 nor the Clear et al. '584 patent is capable of anticipating applicants claimed invention. This is because neither reference discloses or teaches each of the instantly claimed elements and limitations.

The cited art of record also fails to render the instant invention obvious under the provisions of 35 USC § 103(a), since such references, whether considered singularly or in combination, completely fail to provide for, or otherwise

disclose a disposable diaper as instantly claimed, and further fail to provide any motivation to those of ordinary skill in the art that would allow them to arrive at the same.

**CONCLUSION**

Based upon the amendments and remarks presented herein, the Examiner is respectfully requested to issue a Notice of Allowance clearly indicating that each of the pending claims 1-4 are allowed and patentable under the provisions of Title 35 of the United States Code.

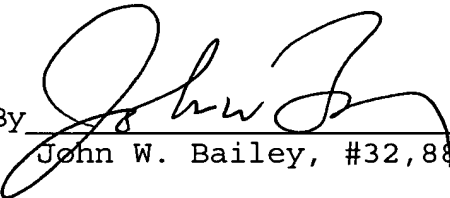
Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Bailey (Reg. No. 32,881) at the telephone number below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Appl. No. 10/058,087

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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By   
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Attachment(s): Rewritten Abstract of the Disclosure